

REMARKS

Claims 1-6, 9, 11-23, 26 and 28-54 are pending in the application. Claims 1, 18, 32, 33, 35, 40, 45 and 50 are currently amended.

The application has been withdrawn from appeal to place the application in better condition for appeal. Specifically, minor amendments have been made to broaden the claims and certain art is provided in an Information Disclosure Statement.

Claims 1, 18, 40, 45 and 50 have been amended to recite additional chelates and a 1% weight percent amount as supported, for example, in paragraphs 30, 31 and 34 of the published application.

Information Disclosure

The Examiner has refused to consider certain references submitted in Information Disclosure Statements dated 10/30/01 and 9/10/02 because these references have not been provided with publication dates. These references were submitted to Applicant during the course of other proceedings, such as reexamination and litigation proceedings involving other patents that the Examiner has cited here. Therefore, Applicant has disclosed these documents as provided in context of the other proceedings. Applicant's attorney does not have access to the original source documents and is unable to provide the missing publication dates. An attached form 1449 provides the additional publication dates that we have been able to ascertain. Applicant requests consideration of these references.

The 35 U.S.C. §112 First Paragraph Rejection of Claims 1-6, 9, 11-17, 32, and 33

Claims 1, 18, 32 and 33 have been amended to recite that the composition works against fungal or bacterial disease. This is in contrast to the former recitation of controlling or preventing. The Office reads these claims in a peculiar way to require 100% efficacy in prevention even in untreated plants, saying:

Applicant's own experiments show that, even untreated, not all of the plants in a sample will exhibit signs of disease and that there was presence of some disease even amongst a sample of treated plants.

On page 3 of the current Office Action, the Examiner reads a further limitation that the treatment or prevention must be permanent.

Applicant objects to and traverses the rejection because the Office is reading limitations of 100% percent efficacy and permanency into the claims. The Examiner inexplicably finds nonenablement on the basis of these presumed limitations that are simply not present in the claims. Even so, we need not engage in this semantic wrangling on the eve of appeal. Applicant has amended the claims to provide compromise language that suitably broadens the claims and/or provides clarification to remove any doubt whether such presumed limitations are included. "Working against" a disease clarifies that 100% efficacy is not required and encompasses both treating and preventing. The Examiner will appreciate that prevention need not be 100% effective and is still prevention in a sample of plants if the incidence of disease is reduced, that control of an existing infection prevents further infection in a sample of plants even if control or prevention is not 100% complete, control or prevention is not necessarily permanent if a pathogen is reintroduced, and the presumed limitations are not present in the claims.

These amendments overcome the Examiner's rejection under 35 U.S.C. §112 first paragraph.

The Double Patenting Rejections of Claims 1-6, 9, 11-23, 26, and 28-54.

Claims 1-6, 9, 11-23, 26, and 28-54 stand rejected for obviousness-type double patenting over claims 1-8 of US 5,736,164, claims 1-5 of US 5,800,837 or claims 1-9 of US 6,338,860 each in view of US 4,139,616 issued to Ducret et al., Fenn et al. (1984), Reuveni et al., (1995), US 4,714,614 issue to Scher, and Supa Crop.

Applicant contests the premise that Supa Crop is prior art. We have no evidence showing Supa Crop was ever a publication. This is merely a label that we believe was provided by an applicant for fertilizer registration in proceedings before an Australian regulatory agency that is now disbanded. We believe proceedings before that agency did not permit use of this particular label and were not a matter of public record. We are in

the process of investigating these issues in Australia, but the investigation is not complete due to difficulties imposed by the disbanding of that agency.

Even if Supa Phos is prior art, and here Applicant makes no admission, the label shows the use of separate phosphonates and phosphites with metals that are shown in weight volume percentages. By this metric, for example, a 5% W.V. solution contains 5g of an ingredient in 100 ml of solution. Totaling the weight chelated metals shows 0.7847% W.V. by weight of metal in Supa Phos. Assuming a 11.5 pound per gallon density as is common in the art, and adjusting for the conversion factor shows that the Supa Phos solutions are only about 0.57% by weight total metal chelates by weight of the metal. This is well below the 1% metal weight limitation of claims 1, 18, 35, 40, 45 and 50.

As stated, the rejection merely finds that discrete documents touch upon isolated aspects of what is claimed, but nothing ties the combination together as a teaching or suggesting to combine the teachings of these documents. Specifically, the claims of the '164, '837, '860 patents show the use of phosphonates and phosphates in combination. The Examiner relies upon Ducret et al. to show that phosphonates are effective fungicides, Fenn et al. to show that phosphonates and phosphates are effective against Phytophthora, and Reuveni et al. to show that potassium phosphates are effective fungicides and fertilizers. Scher is applied to show that FeEDDHA is effective against Fusarium. Supa Phos, which is not necessarily prior art, is applied to show a composition having a different structure than what is claimed.

The '164, '837 and '860 patents have been the subject of prior litigation. Applicant's attorney attaches a document from that litigation, namely, the Rebuttal By Robert C. Adair, Jr. Of Defendant's Expert Report. Although that litigation does not particularly address the present claims, the content of this report illustrates the extreme problems with combining references in the manner that the Examiner suggests, particularly if the 1% weight percent limitation is to be achieved. These remarks address, for example, the Fenn and Reuveni references that are also presently at issue. The Examiner will be particularly interested to read the entire passage from the last paragraph

on page 14 to the first full paragraph on page 16. Furthermore, the passage from pages 8-11 shows that limited uptake pathways are at issue and these can be overwhelmed to produce dramatically different effects at various concentrations of materials. Thus, it cannot be said that the references can be combined from a perspective of skill where experimentation to confirm the combination of particular materials is lacking.

Scher and Supa Phos do not provide such motivation, and none of the other art does so either, where nothing in the combination of references shows how to make and use the solutions at the concentrations that are claimed. Just because materials can be mixed does not mean that one should do so. The art is replete with instances of incompatible materials. The industry publishes lists of such things, for example, as phytotoxic combinations. What the Examiner suggests falls into the realm of undue experimentation and nonenablement until such combinations have been tested on plants. This rejection does not state a *prima facie* case.

The Examiner finds that the art amply teaches combining phosphates with phosphonates and combining the same with metal chelates. We respectfully traverse this finding. Nothing in the prior art of record teaches the concentrations that are claimed or suggests making solutions at these concentrations. As to the combination that is claimed, this would further have to be tested on plants before it is deemed useful from a perspective of skill.

For the reasons stated above, the rejection cannot be sustained.

Claims 1-6, 9, 11-23, 26, and 28-54 stand rejected for obviousness-type double patenting over claims 1-2 of US 6,139,879 in view of US 4,139,616 issued to Ducret et al., Fenn et al. (1984), Reuveni et al., (1995), US 4,714,614 issued to Scher, and Supa Crop.

Applicant incorporates the preceding remarks and reasserts them here in context of US 6,139,879. The '879 patent merely claims the use of zinc, tin, manganese and/or copper in combinations with EDDHA, pEDDHA, and/or EDDHMA. This does nothing to address the problem of combination that is discussed above or the recognized problem of phytotoxicity risk in making willy-nilly combinations of materials in this art.

Applicant requests clarification of the rejection for the reasons that on page 8 the last paragraph applies remarks addressing the '164 patent when this patent is not applied in stating the rejection. These remarks mischaracterize '879 patent if such was intended where, otherwise, the remarks are irrelevant because they are out of context to the stated rejection.

Claim Rejections 35 U.S.C. §103

Claims 1-6, 9, 11-23, 26, and 28-54 stand rejected under 35 U.S.C. §103(a) over Horriere et al. in view of Ducret et al., Fenn et al. (1984), Reuveni et al., (1995), US 4,714,614 issued to Scher, and Supa Crop as applied above.

Horriere et al. is used to show that combining phosphonates with other fungicides, such as maneb and mancozeb show increased effectiveness. This has nothing to do with the materials that are claimed at the concentrations that are claimed.

Applicant incorporates the preceding remarks and reasserts them here in context of rebutting the obviousness rejection. Nothing in the combination of references teaches or suggests the use of the materials that are claimed at the concentrations that are claimed.

Applicant's attorney respectfully solicits a Notice of Allowance in this application. The Commissioner is authorized to charge any additionally required fees to deposit account 12-0600 Should the Examiner have any questions, comments, or suggestions that would expedite the prosecution of the present case to allowance, Applicants' undersigned representative earnestly requests a telephone call at (720) 931-3012.

Respectfully submitted



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